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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/755,536	01/12/2004	David A. Pattillo	09046.0001-00000	1331
22852	7590	01/23/2008		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER .LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER NGUYEN, HUONG Q	
			ART UNIT 3736	PAPER NUMBER
			MAIL DATE 01/23/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/755,536

Applicant(s)

PATTILLO ET AL.

Examiner

Helen Nguyen

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This Office Action is responsive to the amendment filed 5/11/2007. Claims 6, 15, and 24 are amended, overcoming the previous §112 rejections. **Claims 1-27** remain pending.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-5, 9-14, 18-23, and 27** are rejected under 35 U.S.C. 103(a) as being unpatentable over Asphahani et al (US Pat No. 6836744).
4. **Claims 6-7, 15-16, and 24-25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Asphahani et al in view of Demon (US Pat No. 5813142), further in view of Gray et al (US Pat No. 6122846), even further in view of Hoppenstein (US Pat No. 5564202).
5. **Claims 8, 17, and 26** are rejected under 35 U.S.C. 103(a) as being unpatentable over Asphahani et al in view of Demon, further in view of Gray et al, further in view of Hoppenstein, even further in view of Potter et al (US Pat No. 6430843).
6. Please see the Office Action dated 11/14/2006 for complete details.

### *Response to Arguments*

7. Applicant's arguments filed 5/11/2007 have been fully considered but they are not persuasive. Applicant contends that Asphahani et al do not disclose determining a cushioning

requirement, nor determining a shoe based on the level of cushioning and pronation. However, it is noted that Asphahani et al disclose identifying loads on the foot (abst) and motions of pronation (abst) as well as providing proper footwear selection (col.3: 3). It is also obvious to one of ordinary skill in the art that selecting proper footwear requires knowledge of a cushioning requirement as needed for loads placed on the foot as well as the degree of pronation. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to determine a cushioning requirement as well as selected a shoe based on the level of cushioning and the degree of pronation to provide the best fitting shoe for the user.

8. Regarding Claim 1, Applicant also contends that Asphahani et al do not teach a time value. However, it is obvious to one of ordinary skill in the art that due to the time-dependent nature of gait measurements collected, the time variable is a necessary component of such data and can thus be determined.

9. Regarding claims 6, 15, and 24, Applicant contends that the above combination of references do not teach the claimed cushioning requirements. However, it is noted that the combination of the entirety of Asphahani et al, Demon, Gray et al, and Hoppenstein suggest to one of ordinary skill in the art said cushioning requirements as explained above. Furthermore, it is noted that for a proper §103 rejection, "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). "There is no requirement that an "express, written motivation to combine must appear in prior art references before a finding of obviousness." See Ruiz v. A.B. Chance Co., 357 F.3d 1270, 1276, 69 USPQ2d 1686, 1690 (Fed. Cir. 2004). For

example, motivation to combine prior art references may exist in the nature of the problem to be solved (Ruiz at 1276, 69 USPQ2d at 1690) or the knowledge of one of ordinary skill in the art (National Steel Car v. Canadian Pacific Railway Ltd., 357 F.3d 1319, 1338, 69 USPQ2d 1641, 1656 (Fed. Cir. 2004))." See MPEP 2143.01. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA) 1969.

10. Regarding Claims 7, 16, and 25, Applicant contends that Asphahani et al does not teach determining a speed of a forefoot. However, it is noted that angular velocity can be considered a speed, wherein speed according to a physics definition is defined by a magnitude and the angular velocity includes such magnitude. Furthermore, it would have been obvious to one of ordinary skill in the art to determine a speed of the forefoot in light of the teachings of Asphahani et al to gather more data regarding the movement of the foot and subsequently adjust the cushioning requirement based on said speed to enhance the cushioning to best fit the user.

### ***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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Art Unit: 3736

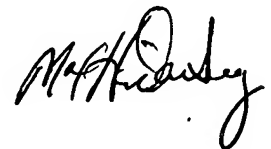
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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen Nguyen whose telephone number is 571-272-8340. The examiner can normally be reached on Monday - Friday, 8 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571-272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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